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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,449	08/10/2000	Kimiya Yamaashi	NIP189	6477
24956	7590	12/02/2004	EXAMINER	
MATTINGLY, STANGER & MALUR, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/635,449	<b>Applicant(s)</b> YAMAASHI ET AL.	
	<b>Examiner</b> Eliseo Ramos-Feliciano	<b>Art Unit</b> 2687	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,11-16,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 25 is/are rejected.
- 7) ☒ Claim(s) 1,3-8 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 30, 2004 has been entered.

### *Claim Objections*

2. **Claim 1** is objected to because of the following informalities (line numbers refer to the claim as presented by applicant's amendment filed July 30, 2004):

in line 12 it reads "that to be", should be --that is to be-- for clarity and precision of language;

in lines 14-15 it reads "that to be", should be --that is to be-- for clarity and precision of language;

in line 17 it reads "forming the data", should be --forming the data groups-- to be consistent with the body of the claim;

in line 20 it reads "said digital broadcast received apparatus", should be --said digital broadcasting receive apparatus-- to be consistent with the body of the claim;

in lines 22-23 it reads "said digital broadcasting", should be --said digital broadcasting data groups-- for clarity and precision of language;

in lines 24-25 it reads "said ordinary broadcasting data", should be --said ordinary data-- to be consistent with the body of the claim; and

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in line 26 it reads "other, from", should be --other, obtained from-- for clarity and precision of language.

Appropriate correction is required.

3. **Claims 25 and 26** are objected to because of the following informalities: in lines 2-3 they read "receiver apparatus", should be --receive apparatus-- to be consistent with the body of the claim and/or the base claim. Appropriate correction is required.
4. For examination on the merits the claim(s) will be treated as suggested.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 11-12 and 25** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim(s) 11 and 12 is/are incomplete because the claim(s) on which it/they depend(s) from has/have been cancelled by applicant's amendment filed July 30, 2004; see MPEP 608.01(n)(V).

In addition, claim(s) 11 and 12 recite(s) the limitation "said information service station" in line 2. There is insufficient antecedent basis for this limitation in the claim(s).

In view of the problems explained above, for examination on the merits the claim(s) will be treated as if dependent on claim 1. In addition, since the limitation "said information service station" lacks antecedent basis as explained, but in view of cancelled claim 9, the claim(s) will be treated as if the subject limitation means --said digital broadcasting receive apparatus--.

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8. Claim(s) 25 is/are incomplete because the claim(s) on which it/they depend(s) from has/have been cancelled by applicant's amendment filed July 30, 2004; see MPEP 608.01(n)(V). The claim will be treated as if dependent on claim 1.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg (US Patent Number 6,091,956) in view of Alten et al. (US Patent Number 5,781,246).

Regarding **claim 13**, Hollenberg discloses a mobile terminal (2; 18, 19) embedding a computer executing plural installed software programs such as map navigation, as depicted in Figures 1-6 and 10-11. The mobile terminal (2) includes communication means (14) for receiving digital broadcasting contents, input means (e.g. touch-screen 4a-4d) for accepting an operation input by a user: "hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The mobile terminal (2) also includes information memory means for storing programs and related data, display means (4) for displaying an execution result of programs and a operation screen; and control means (controller) for managing a program data captured from the communication means and the input means. The information memory means stores management information including information ID of the programs and independent data; see Figure 12; abstract; column 7, lines 41-46,

column 12, lines 13-40 column 18, lines 20-67, column 19, lines 9-14, column 20, lines 54-60, column 21, line 29 to column 23, line 40, and column 25, lines 10-30.

The mobile terminal receives time division multiplex data (see GSM; column 5, line 41). Ordinary data originates from a global communications network (element 31; Figures 1, 3, 5) that includes “services such as electronic mail, entertainment, games, news, television, particularly digital TV, and access to other networks, including the Internet, for example” (column 7, lines 41-46; emphasis added).

The ordinary data are presently on broadcast, while identification data and index data is multiplexed thereon to compose digitally-broadcast data. The index data being broadcast repeatedly (in real time). As depicted in Figure 11, elements 8i, 6w and 6x.

However, Hollenberg fails to specifically disclose discriminating between data already broadcast and data to be broadcast, and further relating identification data with broadcasting hours.

Nevertheless, Hollenberg teaches that the broadcast data can be “particularly digital TV”, as recited above. Consequently, Hollenberg's digital broadcasting receive apparatus may include a digital TV receiver.

In the same field of endeavor, Alten et al. discloses a digital broadcasting system that includes a digital broadcasting receive apparatus or digital TV receiver with on screen “TV guide”; see the abstract. As depicted in Figure 20 of Alten, the composed digitally-broadcast data includes identification data and index data. The identification data permit to discriminate between data already broadcast (for example at 4:30p) and data to be broadcast in the future (for example at 8:00p). The index data relates the identification data with broadcasting hours; notice present time is 6:50pm (element 183). The rest of Alten et al.'s figures contain many other examples of these features.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to complement Hollenberg's digital broadcasting receive apparatus with Alten et al.'s teachings, such as TV guide, because it facilitates the marketing and sale of programs and services; provides the user with flexible and uncomplicated on-screen interface; and provides user with current programming information, *inter alia*, as taught by Alten et al., see column 4, lines 31-42.

Regarding **claim 14**, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claim 13*). In addition, the mobile terminal's control means receives the broadcast multiplexed data. The data includes several components, such as those depicted in Figure 12, including an ID (number or name). The "user selects which of an optional plurality of visit lists to begin downloading" (column 25, lines 13-15). "Mappable hypertext items, may be executably selected by user to provide additional information or execute as computer code" (column 13, lines 36-38). The "hypertext, in which the item name or symbol can be selected or clicked on by a user to provide additional information" (column 22, lines 28-30). The communication means has a receive channel corresponding to a transmission from a download requester as well as a receive channel for the digital broadcasting.

Regarding **claims 15-16**, Hollenberg and Alten et al. disclose everything claimed as applied above (see *claim 13*). However, Hollenberg and Alten et al. fail to particularly disclose an "IC card" or an "external memory media to be inserted" as claimed by applicant.

The examiner contends that an "external memory media" for storing downloaded information, as well as related information (identification indicia, such as, user number),

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is conventionally known in the art for the well known advantage of saving memory space in the subject device, or for expanding the capability of storage of the subject device.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to particularly enable Hollenberg and Alten et al.'s mobile terminal with the capability of an external memory media for storing downloaded information for the advantage of expanding the capability of storage of the subject device, or for saving memory space in the subject device.

***Allowable Subject Matter***

11. **Claim 1** would be allowable if rewritten or amended to overcome the objection set forth in this Office action.

**Claims 3-8** dependent on claim 1 would be allowable if claim 1 is rewritten or amended as indicated above.

**Claim 26** would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

12. Applicant's arguments filed July 30, 2004 have been fully considered but they are not persuasive.

In general, applicant's arguments are directed to the newly added limitations in claim 1. Such newly added limitations are not found in claim 13. Therefore, arguments are more specific than the language of claim 13.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "broadcasting data that is sent or that is to be sent is captured via a network



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separately from the function of receiving the broadcasting data” or “capturing, via a network, the broadcasting data already sent or that is to be sent separately from the function of storing or receiving broadcasting data”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that Holenberg is merely intended for reception of broadcasting based on a current situation and that Alten et al.'s teaching is no different from a conventional program schedule, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### Conclusion

13. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid, can be reached on (703) 306-3016. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERF/erf  
November 18, 2004

  
ELISEO RAMOS-FELICIANO  
PATENT EXAMINER

11/18/04